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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/586,018

10/26/2006

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54084-62559

9316

21888 7590 02/05/2010

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EXAMINER

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ART UNIT

PAPER NUMBER

3739

NOTIFICATION DATE

DELIVERY MODE

02/05/2010

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/586,018
Filing Date: October 26, 2006
Appellant(s): SCHELLER ET AL.

JOSEPH M ROLNICKI
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/11/10 appealing from the Office action mailed 8/14/09.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1, 3-10, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Richards (US 5634918).

Regarding claim 1, Richards discloses an elongate rod [14] adapted to be attached to a surgical instrument head [col. 4, ll. 10-12], a piston [34] mounted on the rod adjacent the rod distal end [Fig. 3], a forward grip member [20] having a plurality of resilient arms [20T, 20H, col. 3, ll. 25-31] that extend along the rod to operatively engage the piston [via elements 22 and 32], whereby manual movement of the arm distal ends radially inwardly [Fig. 4], moves the piston axially toward the rod distal end [Fig. 4], and movement of the piston axially away from the rod distal end moves the arm distal ends radially outwardly [Fig. 3]. If the first position is interpreted as seen in Fig. 4, and the second position is interpreted as seen in Fig. 3, the second radial spacing between elements 20H of each arm is larger than the first radial spacing.

Regarding claim 3, Richards discloses an elongate rod [14] adapted to be attached to a surgical instrument head [col. 4, ll. 10-12], a piston [34] mounted on the rod adjacent the rod distal end [Fig. 3], a forward grip member [20] adapted to have axial movement between first and second positions of the forward grip member relative to the rod [Figs. 3 and 4, 20F], a

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plurality of resilient arms [20T, 20H, col. 3, ll. 25-31] integrally connected with the forward grip member [Fig. 3a] which operatively engage the piston [via elements 22 and 32], whereby manual movement of the arm distal ends radially inwardly [Fig. 4], moves the piston axially toward the rod distal end [Fig. 4], and movement of the piston axially away from the rod distal end moves the arm distal ends radially outwardly [Fig. 3]. If the first position is interpreted as seen in Fig. 4, and the second position is interpreted as seen in Fig. 3, the second radial spacing between elements 20H of each arm is larger than the first radial spacing.

Regarding claim 4, Richards discloses a connector [28] at the rod distal end that attaches the rod to a surgical instrument head [col. 4, ll. 10-12].

Regarding claim 5, Richards discloses the rod connector is adapted for removably attaching the surgical instrument heads [col. 8, ll. 56-57].

Regarding claim 6, Richards discloses the connector [28] has a center bore through it, and the piston [34] has proximal and distal ends, the piston distal end extending through the connector center bore [Fig. 4].

Regarding claim 7, since a slot is defined as “a narrow opening for receiving or admitting something”¹, the part of the lumen [labeled 30] through near the distal end of rod [14] which is adjacent to the connector [28] as seen in Fig. 3, is interpreted as the slot, while the piston proximal end [labeled at 34] is positioned in the slot, and the piston distal end [labeled 34F] is positioned in the connector bore [28].

Regarding claim 8, Richards discloses an elongate rod [14] adapted to be attached to a surgical instrument head [col. 4, ll. 10-12], a piston [34] mounted on the rod adjacent the rod

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distal end [Fig. 3], a forward grip member [20] adapted for axial movement between first and second positions of the forward grip member relative to the rod [20G Figs. 3 and 4, 20F], a plurality of resilient arms [20T, 20H] operatively connected with the piston [via elements 22 and 32] and a ring [22, 32] mounted on the rod wherein the ring is adapted to have reciprocating movement of the ring toward the rod proximal end and toward the rod distal end [col. 4, ll. 39-41], the ring engaging with the piston [Fig. 3], whereby manual movement of the arms radially inwardly moves the piston axially toward the rod distal end [Fig. 4], and movement of the piston axially away from the rod distal end moves the arm distal ends radially outwardly [Fig. 3]. If the first position is interpreted as seen in Fig. 4, and the second position is interpreted as seen in Fig. 3, the second radial spacing between elements 20H of each arm is larger than the first radial spacing.

Regarding claim 9, Richards discloses the ring [22, 32] has a sliding surface which the resilient arms [20H, 20H] engage [24'], the resilient arms moving between the first radial spacing between the arms and the second radial spacing between the arms in response to the sliding movement of the arms on the ring sliding surface [Figs. 3 and 4].

Regarding claim 10, Richards discloses the plurality of arms [20T, 20H] extending from the forward grip member along the rod, the plurality of arms having distal ends that engage with the ring [22, 32, Fig. 3], the axial movement of the forward grip member relative to the rod [20F, Figs. 3 and 4] moving the arms relative to the rod and ring.

Regarding claim 12, Richards discloses the plurality of arms [20T, 20H] extending from the forward grip member [20], the arms operatively engaging with the piston [via elements 22

¹ slot." *Dictionary.com Unabridged (v 1.1)*. Random House, Inc. 06 Dec. 2007. <Dictionary.com

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and 32], the movement of the forward grip member relative to the rod [at 20F] moving the distal ends of the arms relative to the rod [Figs. 3 and 4].

Regarding claim 13, Richards discloses the plurality of arms being circumferentially arranged around the rod and piston [col. 3, ll. 25-31].

(10) Response to Argument

Applicant argues that Richards fails to disclose a forward grip member having a plurality of resilient arms that extend along the rod because the claim language, specifically the term "a" in "a forward grip member", signifies that the forward grip member cannot be comprised of separate elements, such as the six triggers [20] disclosed by Richards. The examiner maintains that the trigger arms [20, Fig. 3] as disclosed by Richards meet the claim limitation because all the triggers are operatively associated and work together to effect a single function, e.g. cause movement of the piston [34]. In this manner, they effectively form a forward grip member, the forward grip member having a plurality of resilient arms [20, 20T, 20H, Fig. 3A]. The examiner notes that if the applicant's interpretation of the word "a" is interpreted as such, then applicant's invention of "a surgical instrument handle" should consist of nothing more than a monolithic stick. The examiner suggests more descriptive claim language, such as --a forward grip member formed of a plurality of integrally connected resilient arms-- which would better suggest a single structure.

Applicant argues that segments 20T of the resilient arms [20] cannot be interpreted as part of the arm distal ends because only tie hooks 20H are operatively engaged with the piston [Brief, pg. 10]. However, elements 20H are part of elements 20T, which together are interpreted

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by the examiner to comprise the distal end portions of the resilient arms. The fact that portion 20H of the arm operatively engages the piston does that preclude that while a part of portion interpreted to be the distal end operatively engages the piston, another portion of the distal end moves between a first and second radial spacing as claimed. Looking at the distal portion of arm 20, including 20T and 20H, as a whole, in Fig. 4 of Richards, which is considered the position in which the piston is moved toward the rod's distal end, the portion around label 20T can be seen as being moved radially inwardly compared to the position of the same spot in Fig. 3, wherein the piston is moved away from the rod's distal end.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Victoria W Chen/

Examiner, Art Unit 3739

Conferees:

/Linda C Dvorak/

Supervisory Patent Examiner, Art Unit 3739

/Tom Hughes/

TQAS, TC 3700

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